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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/097,791	06/16/1998	MICHAEL T. BOYCE-JACINO	13065	3332

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EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 07/16/2002

28

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/097,791

Applicant(s)
Boyce-Jacino et al.

Examiner
Ardin Marschel

Art Unit
1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 15, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-20 and 23-34 is/are pending in the application.
- 4a) Of the above, claim(s) 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-20, 23-28, and 31-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 4-20 and 23-34 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) 2 sheets 6) ☐ Other:

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 6/18/01 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission, filed on 6/18/01, has been entered.

The sequence listing, filed 1/15/02, is acceptable.

Applicants' arguments, filed 6/18/01, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are reiterated. They constitute the complete set presently being applied to the instant application.

Claims 4-18, 28, and 31-34 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 4 has been amended to require that captured template must not contain a region of complementarity to the spacer which is adjacent to the complementarity to the primer region of the

sequencing reagent. Pages 15-16 of the specification has been pointed to for support for this amendment. Consideration of these pages has failed to reveal any spacial limitation as to spacer complementarity as compared to primer complementarity regions such to support the "not adjacent" limitation in part (c) of amended claim 4. This limitation regarding spacer and primer complementarity regions is therefore NEW MATTER due to lacking written description as filed. Claims dependent from claim 4 directly or indirectly also contain this NEW MATTER due to said dependence.

Support for new claim 31 has been pointed to by applicants on page 29 of the specification regarding mass spectroscopy detection of mass change. Consideration of said page 29 citation reveals that only a particular mass spectroscopy is therein cited which is MALDI-TOF mass spectroscopy. No broader or generic mass spectroscopy as now in claim 31 has written basis. This broadening of mass spectroscopy is NEW MATTER compared to said written description as filed.

Claim 32 contains NEW MATTER in that the repeating therein cited is apparently directed to repeating the method for an array. Consideration of the support pointed to on page 24 by applicants reveals that the repetitive method is directed in lines 15-19 to repeating the method for each sequence reagent of an array and not repeating the method over the whole array thus

obtaining multiple patterns wherein each pattern covers a whole array. This repeating of a whole array analysis is now an interpretation of claim 32 and is NEW MATTER compared to said page 24 citation which only repeats the method for each reagent on an array thus resulting in one pattern for the whole array only.

Claims 19, 20, 23-27, and 31 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 19, 20, 23-27, and 31 depend either directly or indirectly from canceled claim 1. This causes them to be vague and indefinite as to what actual limitations are meant thereby.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 19, 20, 23-27, and 31 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Cantor et al. (P/N

5,795,714).

This rejection is reiterated and maintained from the previous office action, mailed 12/15/00, regarding claims that still depend from canceled claim 1 which may be interpreted that applicants intend that the claim 1 method is still meant to be included in these claims. The only arguments of applicants are regarding the claim 4 limitations which are moot for instant claims 19, 20, 23-27, and 31 which do not depend from claim 4 either directly or indirectly. It is especially noted that mass spectrometry detection of labels is disclosed in the reference in column 9, lines 14-16, as also required in instant claim 31.

The disclosure is objected to because of the following informalities:

On page 15, line 20, of the specification the phrase "(FIG. 1; SR)" is present which seems to indicate that a region "SR" is present in Figure 1 corresponding to the spacer region. Confusingly, there is no "SR" in Figure 1, but rather the word "Spacer".

On page 23, line 6, the word "lables" appears to be misspelled in context.

On page 23, line 23, the word "preferableto" seems to be two words run together.

Appropriate correction is required.

No claim is allowed.

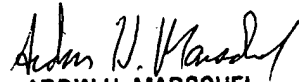
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

July 12, 2002


ARDIN H. MARSCHEL
PRIMARY EXAMINER